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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/649,978	08/26/2003	David N. Nelson	6103	6716
7590 12/20/2006 The Reilly Intellectual Property Law Firm, P.C. 1554 Emerson Street Denver, CO 80218			EXAMINER SPAHN, GAY	
			ART UNIT 3635	PAPER NUMBER
			MAIL DATE 12/20/2006	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/649,978

Applicant(s)

NELSON, DAVID N.

Examiner

Gay Ann Spahn

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 27 November 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See continuation sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 22-34.
Claim(s) withdrawn from consideration: 35-37.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See continuation sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

ADVISORY ACTION (continuation sheet)

CONTINUATION OF BOX 3a (Proposed Amendments):

The proposed amendments filed by facsimile on 27 November 2006 will not be entered because they raise issues that would require further consideration and/or search.

More particularly, the proposed amendments to independent claim 22, dependent claims 25-27 and 30, independent claim 31, and dependent claim 33 would require further consideration and/or search. Therefore, Applicant's arguments on pages 21-29 with respect to how the proposed amendments to independent claims 22 and 31 and dependent claims 25-27, 30, and 33 overcome the 35 USC 112, second paragraph rejections (pages 21-25), the 35 USC 102(b) rejections (pages 25-27), and the 35 USC 103 rejections (pages 27-29) will not be addressed at present as Applicant's amendments and arguments would require more than the cursory review allowed by after final practice.

CONTINUATION OF BOX 11 (Request for Reconsideration/Other):

With respect to drawing objections (pages 2-3 of 11/27/ 06 Amendment):

On page 2 of the Amendment filed by facsimile on 27 November 2006, Applicant has explained that the lead lines leading from reference numeral "108" in Figs. 1 and 3 have been lengthened to extend to the structure represented by reference numeral

"108" and that the lead lines leading from reference numeral "120" in Figs. 1 and 2 have been lengthened to extend to the structure represented by reference numeral "120".

Based on Applicant's amendments to Figs. 1-3 in the proposed Amendment filed by facsimile on 27 November 2006, the examiner agrees that Applicant has overcome her drawing objection spanning pages 5-6 of the Office Action mailed on 26 September 2006.

However, the examiner's drawing objection spanning pages 6-7 of the Office Action mailed on 26 September 2006 is being maintained because the examiner notes that although Applicant has attempted to change "inlet and outlet portion 105a and 105b" to --entrance and discharge portions 105a and 105b-- (see marked-up copy of originally filed specification, page 6, line 7 down from top of page), he has failed to make this same change throughout the specification (see marked-up copy of originally filed specification, page 6, lines 13 and 14 down from top of page, wherein "intake portion 106" was mistakenly changed to --entrance portion 106-- and "inlet portion 105a" was mistakenly not changed to --entrance portion 105a--, respectively, and all other places in the specification where this change should have been made, for instance, last line of page 7, i.e., "intake and outlet portion" and page 10, line 3 of paragraph no. [0020], wherein "outlet part 105b" should have been changed to --discharge portion 105b-- and this failure creates confusion.

With respect to Applicant's statement on page 3 of the Amendment filed by facsimile on 27 November 2006 (i.e., "The outlet portion 108 specifically includes the head assembly 104 which is indicated in the drawings), the examiner notes that it is not

clear how "[t]he outlet portion 108 specifically includes the head assembly 104" and the examiner still does not understand what the difference is between the outlet portion 108 and the head assembly 104. What does the outlet portion 108 include that the head assembly 104 does not? It appears to the examiner that the head assembly 104 and the outlet portion 108 are exactly the same structure, but simply given different reference numerals and different terminology.

With respect to specification new matter (pages 11-16 of 11/27/06 Amendment):

As to (1) on pages 11-12 of the Amendment filed by facsimile on 27 November 2006, Applicant argues that the addition to the specification of the language "[a]n apparatus for separating debris from rock on a surface free of standing water" on pages 4-5 of the Amendment filed on 13 March 2006 does not add new matter. Applicant bases his argument on the fact that the addition of "a landscape surface that is directly exposed to the atmosphere" to claims 1, 13, and 17 in an Amendment filed on 28 March 2005 was not found to be new matter. The examiner does not agree that "the addition of language 'surface free of standing water' is just a further clarification of the landscape surface directly exposed to the atmosphere", and maintains her new matter objection. To say that a landscape surface is directly exposed to the atmosphere is not the same as saying that the apparatus for separating debris from rock is used in an environment wherein a surface is free of standing water.

As to (2) on pages 12-13 of the Amendment filed by facsimile on 27 November 2006, the second full paragraph on page 12 and the first full paragraph on page 13

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refers the examiner's attention to pages 2, 3, 4, and 5 of the Provisional Application from which the present application claims priority. First of all, the examiner notes that the quoted language in the first paragraph on page 13 is not on page 5 of the provisional application, but it is on page 4. Second, the examiner notes that After Final practice is intended for the examiner to make only a cursory review. Applicant cannot simply refer to page numbers of the provisional application and expect the examiner to look through the entire page to find the quoted language as this would require more than a cursory review. If Applicant wants to provide the examiner with the exact page and line numbers of where the quoted language from the provisional application can be found, the examiner would be happy to consider Applicants argument with respect to new matter.

As to (4) on pages 13-14 of the Amendment filed by facsimile on 27 November 2006, Applicant argues that the drawing figures clearly show the inlet portion 105a is extending centrally through an end wall 118a (presumably in Fig. 3?). The examiner disagrees and notes that patent drawings are not drawn to scale. Further, it appears the inlet portion 105a may extend centrally in the direction shown in Fig. 3, the examiner cannot tell whether the inlet portion 105a is centrally located in the direction shown in Fig. 2, because no outline of the inlet portion 105a has been shown in phantom (i.e., dashed lines) in Fig. 2. Thus, it is not at all clear that the inlet portion 105a of the conduit 105 extends centrally through the end wall 118a. The examiner also notes that no end wall has been labeled as 118a in the drawing figures. If Applicants had wanted to make it clear that the inlet portion 105a extends "centrally through", this should have

been disclosed in words in the text of the specification or should have been more clearly shown in the drawing figures by having cross-sectional view. However, nowhere in the text of the specification is there disclosure that the inlet portion 105a extends centrally through anything.

As to (5) on page 14 and the discussion of claim 22 in the second and third full paragraphs on page 17 and the first full paragraph on page 18 of the Amendment filed by facsimile on 27 November 2006, Applicant argues that the language "facilitate advancement of the apparatus in a slightly raised position about the surface to permit the introduction of air, debris and rocks into the intake portion 106" is not new matter citing lines 20-24 on page 5 of the specification and language from claim 1. The examiner notes that in none of the language cited by Applicant is there disclosure that the apparatus is advanced "in a slightly raised position about the surfaces." For all the examiner knows from the original disclosure, the end of the apparatus could be dragged along the surface (i.e., be in contact with the surface). There is absolutely no disclosure supporting the "slightly raised position."

As to (6) on pages 14-15 and the discussion of claims 25 and 26 on pages 18-19 of the Amendment filed by facsimile on 27 November 2006, Applicant argues that drawing figures clearly show that "the handle 110 extends parallel to the longitudinal axis of the intake portion 106 and handle 112 extends at an angle to it." The examiner disagrees as it is not clear what direction that either of handles 110 or 112 "extend" in. The two legs of handle 110 extend outwardly from the outlet portion 108 in a direction that is parallel to the longitudinal axis of the intake portion 106. However, the main

portion of handle 110 between the two legs extends in a direction perpendicular to the longitudinal axis of the intake portion so that it is not clear to the examiner that the entirety of handle 110 extends in a direction parallel to the longitudinal axis of the intake portion 106. Rather, what seems to be true is that the plane of the handle 110 (or a plane bisecting the handle lengthwise) is parallel to the longitudinal axis of the intake portion 106. As to the newly added shape of handle 112, the examiner will not opine as to whether this extends at an angle or not because the newly added shape of handle 112 is simply new matter and Applicants must go back to the shape of originally filed handle as shown in original Figs. 1 and 3 and provide the clarification with respect to that handle that the examiner has requested.

As to (7) on page 15 of the Amendment filed by facsimile on 27 November 2006, Applicant argues that "[t]he head assembly 104 also includes an end portion 113 extending centrally through an end wall 118a into fluid communication with the interior of the intake portion 106" is not new matter because "this particular feature was shown in the original drawings" and for the reasons given in paragraph 6. As stated above, patent drawings are not drawn to scale and thus, it is the examiner's position that is not at all clear from Fig. 3 or any of Figs. 1 and 2 either, that "[t]he head assembly 104 also includes an end portion 113 extending centrally through an end wall 118a into fluid communication with the interior of the intake portion 106." This is particularly true since no end wall 118a nor any end portion 113 was ever disclosed in the specification or shown in the original drawing figures. If Applicants had wanted to make it clear that the head assembly 104 included an end portion 113 extending "centrally through" and end

wall 118 into fluid communication with the interior of the intake portion 106, this should have been disclosed in words in the text of the specification. However, nowhere in the text of the specification is there disclosure that the inlet portion 105a extends centrally through anything.

As to (8) on page 15 of the Amendment filed by facsimile on 27 November 2006, Applicant argues that "[n]ecessarily, the intake portion 106 is of a length substantially greater than that of the outlet portion 108" is not new matter because "Exhibit A and B, submitted with the Provisional Application clearly show that the length of the intake portion is substantially greater than that of the outlet portion." The examiner disagrees that Exhibit A and B submitted with the Provisional Application show much of anything since the exhibits are very dark and it is hard to even determine what is being pointed to with reference numeral "106" (i.e., intake portion) and (reference numeral 108 (i.e., outlet portion).

As to (9) on pages 15-16 of the Amendment filed by facsimile on 27 November 2006, Applicant argues that "[t]he combination of the intake portion 106 and the outlet portion 108 is of a length to extend to the waist level of a user" is not new matter because page 4 of the Provisional Application describes this feature. The examiner notes that After Final practice is intended for the examiner to make only a cursory review. Applicant cannot simply refer to page numbers of the provisional application and expect the examiner to look through the entire page to find the quoted language as this would require more than a cursory review. If Applicant wants to provide the examiner with the exact page and line numbers of where the quoted language from the

provisional application can be found, the examiner would be happy to consider Applicants argument with respect to new matter.

As to (10) and (11) of the Amendment filed by facsimile on 27 November 2006, Applicant argues that the newly added structure of handle 112 as amended in Replacement Sheets of Figs. 1 and 2 is not new matter because the drawing of the handle was clarified at the request of the examiner and the handle 112 has always been shown in the drawing figures. While it is correct that the examiner requested clarification of the handle 112 and that "a" handle 112 has always been disclosed in the drawing figures, the original handle was of a much different structural configuration. Just because the examiner requested clarification does not give Applicant "carte blanche" to completely change the structure of the handle. Therefore, the handle of the structural configuration that is presently illustrated in Figs. 1 and 3 is considered to constitute new matter.

With respect to specification new matter (pages 11-16 of 11/27/06 Amendment):

As to Applicant's discussion of claim 22 on pages 16-18 of the Amendment filed by facsimile on 27 November 2006, Applicant argues that claim 22's recitation of "including an end portion extending centrally through said end wall" as recited in the Amendment filed on 30 November 2005 is not new matter because end portion 105a is clearly described in the patent application specification and shown in Fig. 2. First of all, the examiner notes that reference numeral 105a is not an "end portion", but is called an "inlet portion" in the specification. Second, the examiner notes that claim 22 (as

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amended in the Amendment filed on 30 November 2005) is not reciting that inlet portion 105a extends centrally through said end wall of said intake portion 106, but is reciting that elongated tubular outlet portion 108 includes an end portion (unnumbered) extending centrally through said end wall of said intake portion 106. Fig. 2 appears to be drawn improperly in that Figs. 1 and 3 when looked at together appear to show that outlet portion 108 and head assembly 104 begin at the end wall of the intake portion 106. However, Fig. 2 appears to show that outlet portion 108 and head assembly 104 begin before the end wall of the intake portion 106. Further, Fig. 3 appears to be drawn incorrectly in that the right-hand side outline of outlet portion 108 and head assembly 104 appears to be missing between the lead line from reference numeral 105 and to the end wall of the intake portion 106. Thus, since the drawing figures appear to be drawn incorrectly, they cannot be relied upon to show "an elongated tubular outlet portion . . . including an end portion extending centrally through said end wall" as recited in claim 22 in the Amendment filed on 30 November 2005.

With respect to the language of "to facilitate advancement in a slightly raised position along said surface to permit the introduction of air, debris and rock into said intake portion" constituting new matter, the examiner points Applicant's attention to the discussion of the same language in the specification and why she believes it still constitutes new matter.

As to Applicant's discussion of claims 25 and 26 on pages 18-19 of the Amendment filed by facsimile on 27 November 2006, the examiner refers Applicant's

attention to the discussion of the same language in the specification and why she believes it still constitutes new matter.

As to Applicant's discussion of claim 27 on page 19 of the Amendment filed by facsimile on 27 November 2006, the examiner notes that while handle 110 has been clearly shown to be located on the outlet portion 108, it is not clear that the handle 112 is located on the intake portion 106. This is why she requested clarification of handle 112. In Fig. 3, the handle 112 appears to be located on the intake portion 106. However, in Fig. 1, part of the handle portion appears to be located on the outlet portion 108. Therefore, because of the conflicting drawing figures, the location of handle 112 is still considered to constitute new matter.

As to Applicant's discussion of claim 29 on page 19 of the Amendment filed by facsimile on 27 November 2006, the examiner notes that patent drawings are not drawn to scale and further, exhibits A and B in the Provisional Application are of such poor quality as to not clarify the relative lengths of the intake and outlet portions. Therefore, to add the recitation that "said intake portion is at least twice as long as said outlet portion" without having that same disclosure in the text of the specification, the newly added language is still considered to constitute new matter.

As to Applicant's discussion of claim 31 on page 20 of the Amendment filed by facsimile on 27 November 2006, the examiner notes that Applicant has only referred to page 5 of the specification for support of two recitations found to constitute new matter. The examiner notes that After Final practice is intended for the examiner to make only a cursory review. Applicant cannot simply refer to page numbers of the specification and

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expect the examiner to look through the entire page to find the quoted language as this would require more than a cursory review. If Applicant wants to provide the examiner with the exact page and line numbers of where the quoted language from the specification can be found, the examiner would be happy to consider Applicants argument with respect to new matter.

As to Applicant's discussion of claim 33 on page 21 of the Amendment filed by facsimile on 27 November 2006, the examiner notes that it is not clear what is meant by "a diameter of said open entrance end is equivalent to a diameter of said opposite end wall." Does equivalent mean equal? Since patent drawings are not drawn to scale, it is not clear that the diameters of the open entrance end and the opposite end wall are equivalent and thus, Applicant's reliance on drawing Fig. 3 to shown equivalence is misplaced. The examiner maintains that the recitation of claim 33 constitutes new matter.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gay Ann Spahn whose telephone number is (571)-272-7731. The examiner can normally be reached on Monday through Thursday, 8:30 am to 7:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Naoko N. Slack can be reached on (571)-272-6848. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

^{GAS}
Gay Ann Spahn, Patent Examiner
December 13, 2006

Robert Canfield
Primary Examiner
